

#### REMARKS

In response to the Official Action mailed February 7, 2001, Applicants amend their application and request reconsideration. In this Amendment, no claims are added or cancelled so that claims 1-14 remain pending.

The Examiner noted some spelling errors in certain of the figures. All of the figures have carefully reviewed and an attempt has been made to correct all spelling errors.

The claims have been totally reviewed and amended for clarity. It is apparent from reading the specification, that claims 1-5 encompass what is described as the first embodiment of the invention and claims 6-14 encompass to the description headed "second embodiment". The two embodiments, are somewhat different and thus they are briefly described below.

In the first embodiment of the invention, the contact lens selling system includes three different kinds of terminals, i.e., information processing apparatuses. The simplest possible arrangement is illustrated in Figure 1 in which one of each of the first, second, and third information processing apparatuses are illustrated schematically. The first type of information processing apparatus illustrated by reference number 2, represents information processing apparatuses that are installed in locations for use by distributors or supply agencies of contact lenses. The second kind of information processing apparatuses, illustrated by reference number 3 in Figure 1, are terminals that available to contact lens users. These terminals may serve one or may serve many users and need not be owned by users. It is only essential that users have access to these terminals. The third type of information processing apparatuses, illustrated by reference number 4 in Figure 1, are exclusively installed in locations where ophthalmic examinations are carried out.

As explained in the patent application, a contact lens user has an eye examination carried out at an ophthalmic examination department. A different entity, a contact lens supplying agency, actually sells contact lenses to the user. In the invention, the user, at one of the terminals 3, can communicate with and order contact lenses from a distributor using one of the terminals 2. In response to the information received from the user, either placing an order or requesting ordering information, the supplier or distributor, using one of its terminals 2, can communicate directly with the ophthalmic examination department at its terminal 4 to obtain the prescription. At the same time, information is exchanged to ensure

that the contact lens user is correctly identified. The contact lens user at a terminal 3 cannot obtain this prescription information directly from the ophthalmic department and no one, except the ophthalmic department, can alter the prescription information available from the terminal 4. This limitation in access to the information from the ophthalmic examination department is made clear in the description from page 11, line 26 through page 12, line 15. Amended claim 1 further makes the limitation on exchange of information expressly clear.

The second embodiment of the invention differs from the first embodiment in that the terminals, i.e., information processing apparatuses, for the contact lens user are not employed. Instead, a portable recording medium that is uniquely identified with respective contact lens user is employed. The schematic illustration of Figure 3, shows that the distributor or seller of contact lenses employs the information processing apparatuses 22, rather than the terminals 2 of Figure 1, and that the examining ophthalmology departments use the terminals 24 in place of the information processing apparatuses 4 of Figure 1. The contact lens user terminals 3 of the embodiment of Figure 1, corresponding to the second information processing apparatuses of claims 1-5, are replaced by the portable recording media 23 schematically illustrated in Figure 3. Preferably, these media consist of IC cards but can also be floppy discs or identification cards carried by contact lens users. These cards allow the user to seek a supplier of contact lenses. Then, the cards can be used with information processing apparatus of the selected distributor who can communicate directly with the ophthalmology department to obtain prescription information. The identification media has an associated password to ensure that only one contact lens user can use a particular recording medium. See the disclosure from page 16, line 26 through page 17, line 7. As well known, contact lenses have a limited lifetime. Using the information recorded in the medium, at the time of ordering or purchasing contact lenses, the user is reminded of the next date at which the contact lenses must be replaced, i.e., exchanged. See the disclosure at page 21, lines 5-19. Both of these features are brought out in amended claim 6.

All claims were rejected as unpatentable over Walker et al., U.S. Patent 5,794,207 (hereinafter Walker) in view of Schlueter, U.S. Patent 5,974,124. This rejection is respectfully traversed.

All comments in the Official Action concerning claims 1-5 make reference solely to Walker. It is thus presumed that claim 1 is rejected solely as obvious over Walker without consideration of Schlueter.

To establish *prima facie* obviousness of each of claims 1-5, Walker must describe or clearly suggest each of the terms of those claims. Walker fails to meet that minimum requirement for establishing obviousness. Thus, the rejection cannot be maintained.

As understood, Walker concerns an electronic bidding and payment system much like existing Internet auctions. The system is completely open, meaning that no special information for which the distribution is controlled, such as a medical prescription, is involved. Every diagram of apparatus and all description within Walker suggests that each terminal has a complete right of access to each other terminal, through the central controller. The central controller is analogized by the Examiner to the network of claims 1-5. Thus, Walker fails to even subtly suggest an important feature of the invention, i.e., the absence of complete symmetrical communication between the first, second, and third information processing apparatuses as described in the clarified and amended claims. Thus, for that reason, the rejection cannot be maintained.

Independently, many of the assertions of the Official Action with respect to claim 1 are simply without support. While it is true that the apparatus described in Walker is successful in communicating various information between various terminals, none of that information has anything to do with ophthalmology or contact lenses. Clearly, Walker is directed to sale of various commodities, be they services or goods, that are not specialized for particular purchasers. Medical prosthesis, prescription medications, and contact lenses certainly are not the subject of anything that would be bought and sold by auction as in Walker. Thus, the many assertions in the Official Action about the "inherency", i.e., that Walker encompasses moving information relating to ophthalmology, is simply erroneous. There is no doubt, that the information moved in the Walker system and in the invention consists of, at some stage, ones and zeros. However, that similarity is not an appropriate basis for determining patentability. Otherwise, the initial communication over wires using ones and zeros, for example, nineteenth century telegraphy, would prohibit patenting of every subsequent communication over wires of any kind of information that uses binary code. Moreover, nothing in Walker pertains to or suggests ophthalmology, the only source

of the inherency argument is the invention itself, a prohibited source of prior art. For these additional reasons, the rejection is fundamentally erroneous.

The foregoing comments are principally directed to claim 1, an independent claim. Claims 2-5 are patentable because they depend from claim 1. Applicants reserve the right to present additional reasons for patentability with respect to these dependent claims, if necessary, at a later time.

In discussing the second independent claim, claim 6, the Official Action makes reference not only to Walker but also to Schlueter. The reliance upon Schlueter is misplaced. Schlueter is concerned with a system in which diagnostic information, recorded either in a physician's office or a location remote from a physician's office, is converted into data that can be transmitted, for example, over telephone lines for storage and for subsequent referral and transmission to other medical practitioners. In the described system, this information may also be recorded by a patient into a smart card that is later presented to the physician or medical practitioner for transfer into the medical practitioner's computer. The stored information may be later disseminated at the physician's instruction.

Nothing in Schlueter pertains to using a physician or medical practitioner's examination results to purchase goods as in the invention. In the invention described in claim 6, a password protected medium is carried by the contact lens user in order to purchase contact lenses. The information recorded in the medium is employed by the dispenser of contact lenses to confirm the prescription before dispensing. No connection between the storage and transmission of medical condition information and the purchasing of goods related to the medical condition is present in Schlueter. The very absence of that connection to the sales of goods in Schlueter eliminates the possibility that a person of skill in the art would look to Walker for a modification of Schlueter. Put the other way, since Walker is the primary reference and concerns the auctioning of commodity services or goods, there is nothing in Walker that would suggest to one of skill in whatever is the relevant art, a modification of Walker by Schlueter since Schlueter concerns medical diagnoses, an area traditionally free of the mundane huckstering of Internet auctions. In other words, the rejection is erroneous because there is no reasonable basis for combining Walker with Schlueter or Schlueter with Walker.

Further, the combination would still not suggest the claimed invention as defined by amended claim 6 and its dependent claim 7-14. In the contact lens selling system according to claim 6, the information processing apparatuses included in the first group record at least one of the data and a registration number uniquely in a portable recording medium. In other words, each medium contains a unique registration number and associated data. In the Official Action, it was asserted that the primary computer 100 of Schlueter corresponds to the information processing apparatuses of the first group of claim 6. However, the primary computer 100 in Schlueter includes no means for writing into or reading data from any portable recording medium. Moreover, if the remote computer 50 of Schlueter is assumed to correspond to the information processing apparatuses of the first group, the terms of the claim are still not met because that remote computer 50 is not equipped with a means for writing a registration number or data of any kind into a portable recording medium. Rather, the data receptacle 10, i.e., the portable recording medium of Schlueter, is used to carry data from medical instruments to a remote computer where the information is read by the remote computer 50. That remote computer never has a reason to and is not described as ever writing information into the data receptacle 10. Thus, Schlueter, even in combination with Walker, can neither disclose nor suggest the information processing apparatuses of the first group as described in claim 6 and its dependent claims 7-14.

With regard to dependent claim 10, the Official Action asserted that Schlueter describes a plurality of information processing apparatuses that can read data from all of the portable recording media and write data in all of the portable recording media. The Examiner made reference to the abstract of Schlueter in rejecting claim 10. However, it does not appear that the abstract or any other part of Schlueter describes this limitation of claim 10 involving reading and writing data on all of the portable recording media. Instead, Schlueter is directed to a collection of data in a computer network. That data is entered at one location and read elsewhere in the network without the writing of the information on a portable medium. Thus, the rejection of claim 10 does not meet the terms of that claim and is clearly erroneous independent of the rejection of its parent claim 6.

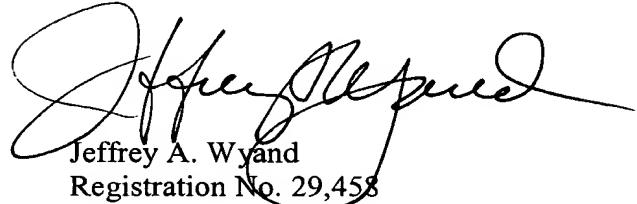
Upon reconsideration, the rejection of claims 7-14 should be withdrawn.

In re Appln. of Tanaka et al.  
Application No. 09/209,454

Reconsideration, withdrawal of the rejections, and prompt allowance of claims 1-4  
are earnestly solicited.

Respectfully submitted,

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